

### **REMARKS**

Claims 1, 2, 4-11, 14, 15, and 17-33 are all the claims presently pending in the application.

It is noted that the claim amendments, if any, are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability except for a search for wording to address statutory subject matter. Further, Applicants specifically state that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

The Examiner objects to the specification.

The Examiner also objects to claim 18 as depending from a canceled claim. Applicants have amended claim 18 to correct its dependency.

The Examiner presents a proposed claim that allegedly would permit claims 1-7 to pass to allowance if claims 8-33 were to be canceled.

Claims 1, 2, 4-11, 14, 15, and 17-33 stand rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. There are no prior art rejections in the rejection currently of record.

Applicants respectfully traverse the Examiner's objection to the specification, respectfully decline to accept the Examiner's proposed claim and claim cancellation, and respectfully traverse the statutory subject matter rejection, as follows.

### **THE SPECIFICATION OBJECTION**

This Examiner has required that Applicants rewrite portions of the specification in accordance with his personal preferences, particularly relative to the usage of the terms "transmission media" and "signal-bearing", indicating that "[p]aragraph 0203 must be amended so that a transmission media can not be used as a storage media."

In response, Applicants note that there is complete agreement between the USPTO and Applicants that, as declared by the Examiner on page 6 of the latest Office Action, "... *carrier waves and other similar transmission media [cannot] be used as storage media*" for computer

instructions. Therefore, it is only logical to conclude that the paragraph [0203], which specifically relates to storage of computer instructions, is not using the term “transmission media” in any possible meaning as describing a medium that can store instructions. This term is described in any number of references, for example, at Wikipedia.org, wherein is described:

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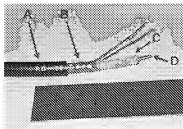
A **transmission medium** (plural *transmission media*) is a material substance (solid, liquid or gas) which can propagate energy waves. For example, the transmission medium for sound received by the ears is usually air, but solids and liquids may also act as transmission media for sound.


The absence of a material medium (the vacuum of empty space) can also be thought of as a transmission medium for electromagnetic waves such as light and radio waves. While material substance is not required for electromagnetic waves to propagate, such waves are usually affected by the transmission media through which they pass, for instance by absorption or by reflection or refraction at the interfaces between media.

The term **transmission medium** can also refer to the technical device which employs the material substance to transmit or guide the waves. Thus an optical fiber or a copper cable can be referred to as a transmission medium.

A transmission medium can be classified as a:

- *Linear medium*, if different waves at any particular point in the medium can be superposed;
- *Bounded medium*, if it is finite in extent, otherwise *unbounded medium*;
- *Uniform medium* or *homogeneous medium*, if its physical properties are unchanged at different points;
- *Isotropic medium*, if its physical properties are the same in different directions.



 Coaxial Cable, one example of a **transmission medium**

Electromagnetic radiation can be transmitted through an optical media, such as optical fiber, or through twisted pair wires, coaxial cable, or dielectric-slab waveguides. It may also pass through any physical material which is transparent to the specific wavelength, such as water, air, glass, or concrete. Sound is, by definition, the vibration of matter, so it requires a physical medium for transmission, as does other kinds of mechanical waves and heat energy. Historically, various

aether theories were used in science and thought to be necessary to explain the transmission medium. However, it is now known that electromagnetic waves do not require a physical transmission medium, and so can travel through the "vacuum" of free space. Regions of the insulative vacuum can become conductive for electrical conduction through the presence of free electrons, holes, or ions.

### Telecommunications

Many transmission media are used as a communications channel.

For telecommunications purposes in the United States, Federal Standard 1037C, transmission media are classified as one of the following:

- Guided (or bounded) - Waves are guided along a solid medium such as a transmission line.
- Wireless (or unguided) - Transmission and reception are achieved by means of an antenna.

Wireless media may carry surface waves or skywaves, either longitudinally or transversely, and are so classified.

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It is clear from the above description that usage in the specification of "transmission media" is related to the equipment used for transmission (e.g., similar to the "technical device" of the above-recited definition from Wikipedia), since the relevant (original) wording in this sentence is: "... the instructions may be stored on a variety of machine-readable data storage media, such as .... or other suitable signal-bearing media including transmission media such as digital and analog and communication links and wireless."

Relative to the term "signal-bearing", Applicants have already explained that this adjective does not refer to a "signal, *per se*". Rather, this descriptive is used to indicate the functionality between the storage media and the instruction, thereby clearly addressing the USPTO's concern in the original computer guidelines a number of years ago that claims distinguish between storage of instructions as tangibly embedded on a medium that is readable by a machine versus a piece of paper having written or typed on its surface a set of instructions. There is no functionality in the case of a piece of paper.

However, in an attempt to expedite prosecution, Applicants have amended the specification to delete completely this paragraph and the descriptive "signal-bearing."

Therefore, there is clearly no longer any possible basis to support the USPTO position that the specification somehow is describing that signals are used for storage of computer

instructions, since there is no reasonable technical explanation anywhere in the specification that signals are somehow serving as a storage medium (and never was). Both the USPTO and Applicants agree that signals, *per se*, are not suitable media for storage of computer instructions.

### THE EXAMINER'S PROPOSED CLAIM

Applicants respectfully, but expressly, decline the Examiner's proposed claim since it represents a perfect example of a prima facie invalid patent claim by reason that its limitations include both apparatus elements and method steps (e.g., a hybrid claim). Applicants also expressly decline to adopt the Examiner's proposal to drop the apparatus claims and storage media claims, since both apparatus claims and storage media claims are directed to statutory subject matter, as a matter of law, in spite of the Examiner's contrary statements and implications.

It is noted that, had Applicants accepted the Examiner's proposed hybrid claim and canceled the remaining claims as required by this Examiner, Applicants would have been left with a single set of invalid claims, with no fallback protection of claims for any of the other categories specifically identified in 35 USC §101, perhaps a perfect example of a basis for legal malpractice against Applicants' representative, to permit Applicants to accept such proposal.

This Examiner's claim drafting attempt is also perhaps a perfect example of why patent examiners should refrain from attempting to draft a set of patent claims, since the USPTO is clearly not going to be willing to stand up in front of a Court in defense of their examiners' attempts to provide patent protection for a set of claims that would almost certainly have brought a malpractice suit against a practitioner.

As this Examiner should now be aware, based on this fundamentally deficient attempt to draft an independent claim, drafting patent claims is not as easy as it might seem to patent examiners. A well-thought-out set of patent claims typically involves hours of effort and several attempts.

Relative to the Examiner's conclusory statements on pages 3 and 4 of the latest Office Action concerning independent claims 8, 11, 14, 20, and 25, the Examiner is respectfully requested to provide reasonable prior art references in support of these statements, the prior art

references also being consistent with the description in Applicants' specification and the plain meaning of the language of these claims, as would be acceptable to one having ordinary skill in the art.

### FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1, 2, 4-11, 14, 15, and 17-33, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Assignee's Deposit Account No. 50-0510.

Respectfully Submitted,



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